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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/982,075      | 10/19/2001  | Satoru Okada         | 723-1190            | 8698             |

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EXAMINER

ENATSKY, AARON L

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/982,075

Applicant(s)

OKADA ET AL

SD

Examiner

Aaron L Enatsky

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21, 22 and 25-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 22 and 25-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Response to Amendment*

1. Examiner acknowledges receipt of amendment on 9/16/02.

### *Specification*

2. **SECOND REQUEST:** The attempt to incorporate subject matter into this application by reference to multiple provisional applications is improper because US provisional applications are not publicly available. Please remove the incorporation by reference to the provisional applications. This application claims priority to the provisional applications, therefore the subject matter included in the provisional applications should be the same as this application.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-22, 33, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi et al. '296 (Hereinafter, Shir). Shir teaches of a high speed data processor used with electronic games having the ability to reduce the processor speed to accommodate the electronic game software designed to run on a slower processor (1:10-24). Shir also discloses that the processor speed can be of multiple speeds, not limited to two speeds (3:16-18). As Shir teaches the variable speed process for use with video games, it is obvious that structural elements of a

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memory media for graphics and sound data, video output, and a connector for coupling the above elements are present in the above teachings, as it is notoriously well known that video game systems use the above-mentioned items. Shir though, does not teach the use of a storage media storing clock speed data, rather that a user would select the correct clock speed. As Shir clearly teaches manually altering processor speeds for use with electronic gaming systems one would have been motivated to include the correct processor speed with a specific game as it obvious to automate a manual process. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching Shir and include processor speed configurations with a specific game to reduce the burden on a user of manually switching between processor speeds for a particular game. Additionally, it is notorious well known that games and game system function can be duplicated in portable or console system format where a portable game system would include the claimed features of handheld game play, LCD display, and DMA operation.

Claims 25, 27-29, 34, and 36-37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shir as applied to claims 21-22 above, and further in view of Sanemitsu '043 (Hereafter, Sane). Shir teaches the claimed limitations as discussed above, but does not teach storing compatibility data in a memory storage medium. Sane teaches a memory storage device that stores compatibility data so that a determination can be made as to the interoperability between a host system and the memory device can be ascertained using device IDs (Abstract). One would be motivated to modify Shir to include the compatibility data in the game memory medium taught by Sane to determine device interoperability as taught by Sane. It would have been further obvious to include the compatibility as it is notoriously well known that memory mediums such as floppy disk, which can be used in games machines, are formatted specifically for certain

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systems. For instance a floppy disk formatted for a PC has certain identifying attributes such as a file system which uniquely identifies a PC formatted disk to be compatible for a PC, where as a competing computing systems will likewise have a different format to identify compatibility. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shir to include compatibility data on a memory storage medium as taught by Sane to determine device interoperability.

Claims 26, 30, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shir in view of Sane as applied to claims 21-22, 25, 27-29, 31-32 above, and further in view of Goshima et al. '728 (Hereafter, Gosh). Shir in view of Sane teach the limitations as discussed above, but fail to disclose specifics of compatibility data related to color information. Gosh teaches a color conversion system that stores color compatibility data for converting an original image into desired color (2:10-68). One would be motivated to modify the game system taught by Shir in view of Sane with color compatibility data taught by Gosh so that any color conversion that takes place will faithfully reproduce the image and reduce the time taken to reproduce the image. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the color compatibility data taught by Gosh in the compatibility data memory of the game system taught by Shir in view of Sane.

#### ***Response to Arguments***

4. Applicant's arguments filed 9/16/02 have been fully considered but they are not persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further obviousness is supported with respect to the fact that automating a manual process is notoriously well known, especially in electronic systems. The impetus behind development of hardware and software is often process automation. In *re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

#### ***Citation of Pertinent Prior Art***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ng '478, discloses well-known features in a portable handheld gaming device such as an LCD screen, removable memory banks, and DMA operation.

Franchi '533, discloses that console game features are readily duplicated in a portable game machine.

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Peppel '216, discloses the concept that games are built not to conform to a specific game system, but as disassociated programs capable of operating on a variety of machines, which further supports feature duplication in a console or portable game machine.

*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

✓ Aaron Enatsky

*A.E.*

November 22, 2002



JESSICA HARRISON  
PRIMARY EXAMINER